

REMARKS

This is intended as a full and complete response to the Final Office Action dated October 8, 2003, having a shortened statutory period for response set to expire on January 8, 2004. Please reconsider the claims pending in the application for reasons discussed below.

Claims 1-9, 11, 12, 14 and 15 remain pending in the application and are shown above. The Examiner has allowed claim 4. Applicant thanks the Examiner for this allowance. Claims 1-3, 5-9, 11, 12, and 14 stand rejected. Applicant has amended claims 11 and 12 to correct matters of form. No new matter has been added. Applicant respectfully requests reconsideration of the rejected claims for reasons presented below.

Claim 14 stands rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,255,751 (*Stogner*). The Examiner states that *Stogner* discloses a method for facilitating the connection of tubulars using a top drive, the method comprising the steps of adjusting a supporting member 22 supporting a tool 23 to cause the tool to be displaced horizontally relative to the top drive (column 2, lines 24-26, column 4, lines 1-11, 67 and 68, and col. 5, lines 1-3). The Examiner further states that it is inherent that the supporting member of *Stogner* is attached to a top drive not shown in the drawing as is known in the art.

Applicant respectfully traverses this rejection. *Stogner* discloses a drill pipe make-up and breakout tool comprising an upper housing, lower housing (each housing with a jaw) and spring-biased legs for holding, aligning and rotating drill pipe. *Stogner* further discloses the upper housing comprises a reversible rotating jaw that may utilize a hydraulic motor, for example, to provide motive force to the jaw [col. 4, lines 7 – 11]. In other words, the top drive is not used to provide rotation and torque to make up and breakout the tubular connection, rather, the upper housing comprises a drive system that is independent of the top drive. Therefore *Stogner* does not teach, show, or

suggest a method for facilitating the connection of tubulars using a top drive, the method comprising the steps of attaching a tool to the top drive using a supporting member and adjusting the supporting member to cause the tool to be displaced horizontally relative to the top drive, as recited in claim 14, and its dependent claim 15.

Claims 1-3 and 5-9, 11, 12, and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Stogner* in view of U.S. Patent No. 4,625,796 (*Boyadjieff*). The Examiner states that *Stogner* discloses an apparatus for facilitating the connection of tubulars using a top drive, the apparatus comprising a supporting member 22 for supporting a tool 23 and a means for allowing substantially horizontal and vertical movements of the supporting member (col. 2, lines 24-26, col. 4, lines 1-11, 67 and 68, and col. 5, lines 1-3). The Examiner further states that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have attached the top drive of *Stogner* to a plate, in light of the teachings of *Boyadjieff*, as is conventional in the art.

Applicant respectfully traverses the rejection. As described above, *Stogner* does not disclose the use of a top drive to make-up and break out tubular connections. *Stogner* does not teach, show or suggest an apparatus for facilitating the connection of tubulars using a top drive, the apparatus comprising a plate attachable to said top drive, a supporting member for supporting a tool and a means for allowing substantially horizontal movement of said supporting member, as recited in claim 1, and its dependent claims 2-3, 5-9 and 11-12.

Further, attaching the plate 48 disclosed in *Boyadjieff* to the top drive of *Stogner*, would not yield an operable connection make-up and breakout system. *Stogner* discloses that prior to the make-up of a connection, the upper and lower tool joints are positioned within the upper and lower housing via hoists [*Stogner*, col. 4, lines 58-67]. If a plate is utilized to attach the top drive and tool of *Stogner*, it would not be possible to position the tool joints within the upper housing and lower housing, as described in *Stogner*.

For the reasons stated above, Applicant respectfully requests allowance of claims 1-3, 5-9 and 11-12.

In conclusion, the references cited by the Examiner, alone or in combination, do not teach, show, or suggest the invention as claimed.

Having addressed all issues set out in the Final Office Action, Applicant respectfully submits that the claims are in condition for allowance and respectfully requests that the claims be allowed.

Respectfully submitted,



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